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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,543	04/20/2004	Jose Costa-Requena	NOKM.095PA	3880
7590 Hollingsworth & Funk, LLC Suite 125 8009 34th Avenue South Minneapolis, MN 55425			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/828,543

Applicant(s)

COSTA-REQUENA ET AL.

Examiner

Joseph E. Avellino

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 10/29/05

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-41 are presented for examination; claims 1, 14, 22, 33, 40, and 41. The Office acknowledges the preliminary amendment adding claim 41.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 40 is rejected under 35 U.S.C. 101 because the claim is not statutory. The claim is a means-plus-function claim and as such can be implemented in software alone (specification, ¶ 87). As such, the "system" is merely an interrelationship of software components, and is merely software, per se and fails to establish a statutory category of invention.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 2, 7, 9, 10, 14, 15, 20-23, 27-29, 33, 34, and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinohara (US 2002/0132608) (cited by applicant in IDS).

4. Referring to claim 1, Shinohara discloses a method of exchanging multimedia data between a multimedia device (i.e. terminal 20) and a network (i.e. network 60), comprising:

digitally coupling a communication device (i.e. telephone 10) to the multimedia device (Figure 1; ¶ 35);

storing, on a data store (i.e. MMS user database server 30) accessible via the network (i.e. network 60), a profile (i.e. data) of the communications device (i.e. mobile telephone 10<sub>14</sub>), the profile adapted to include a description of multimedia capabilities of the multimedia device (i.e. extension of the range of formats that each of the mobile telephones can receive...the current connection of external terminal 20<sub>1</sub> to mobile telephone 10<sub>1</sub> enables the reception of not only multimedia data of format 1, but of multimedia data, media data of format 2, that includes video data of format V2. The arrows in FIG. 4 indicate that the media type is the same as the media type of format 1) (Figure 4; ¶ 39-40);

accessing the profile for purposes of formatting the multimedia data via a network entity (i.e. results of the determination as to what the receiver formats can be received) (e.g. abstract);

formatting the multimedia data (i.e. multimedia message) via the network entity (i.e. transmitting entity) based on the profile so that the data is compatible with the multimedia device (i.e. based on the determination, alter the message to conform to the format the receiver can receive) (e.g. abstract); and exchanging the multimedia data between the multimedia device and the network via the communications device (i.e. transmission and reception of data) (e.g. abstract; ¶ 54).

5. Referring to claim 2, Shinohara discloses the multimedia device comprises an audio playback device (i.e. format 2 is capable of playing the media type of "audio") or a television (the Office construes any device which is capable of playing motion video a television, such as the terminal which is capable of playing a different version of video file) (Figure 4; ¶ 38-42).

6. Referring to claim 7, Shinohara discloses the network entity comprises a MMSC (i.e. multimedia message service) (Figure 1; ¶ 10).

7. Referring to claims 9 and 10, Shinohara discloses the communication device comprises a wireless mobile terminal (i.e. a mobile telephone 10) (Figure 1).

8. Claims 14, 15, 20-23, 27-29, 33, 34, and 38-41 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara.

10. Referring to claim 8, Shinohara discloses the invention substantively as described in claim 1. Shinohara does not explicitly disclose that when the terminal is uncoupled from the mobile telephone, the profile is updated to remove the description of the multimedia capabilities of the multimedia device, however does disclose that if a terminal connects to a mobile telephone, the new information regarding the processing capabilities can be automatically transmitted from the mobile telephone to the MMS user database server (¶ 42). One of ordinary skill in the art would know that a terminal can disconnect if it can connect to a particular terminal, and, based, on the information disclosed in Shinohara, the telephone would be able to notify the MMS user database server of the new information regarding the processing capabilities (i.e. the removal of the particular version and formats).

11. Claim 19 is rejected for similar reasons as stated above.

Claims 3-6, 16-18, 24-26, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of Coussement (US 2002/0114278).

12. Referring to claim 3, Shinohara discloses the invention as described in claim 1. Shinohara does not explicitly state the particular format of the device profile. In analogous art, Coussement discloses another terminal capability determination system which discloses the profile comprises an XML formatted document (§ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile format used in Shinohara with the profile format described in Coussement in order to provide the benefits commonly known to the use of XML, such as the ability to define values to be used in the profile, thereby tailoring the system to the user's liking.

13. Referring to claim 4, Shinohara discloses the invention as described in claim 1. Shinohara does not explicitly disclose the particular format of the device profile. In analogous art, Coussement discloses another terminal capability determination system which discloses the profile comprises a user/agent profile (§ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile format used in Shinohara with the profile format described in Coussement in order to provide the benefits commonly known to the use of XML, such as the ability to define values to be used in the profile, thereby tailoring the system to the user's liking.

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14. Referring to claim 5, Shinohara-Coussement discloses the use of a Profile-Diff header in a message sent to the data store in order to update the profile information (i.e. since Coussement discloses the use of CC/PP repository, it inherently discloses the use of a Profile-Diff header since this is defined as part of the CC/PP exchange protocol, see Ohto et al. "CC/PP exchange protocol based on HTTP Extension Framework" W3C Note 24 June 1999) (§ 21).

15. Referring to claim 6, Shinohara discloses the invention as described in claim 1. Shinohara does not explicitly disclose the particular format of the device repository. In analogous art, Coussement discloses another terminal capability determination system which discloses the use of a CC/PP repository (§ 21). It would have been obvious to one of ordinary skill in the art to substitute the profile repository of Shinohara with the profile repository used in Coussement in order to provide the benefits commonly known to the use of CC/PP repository, such as providing a standardized mechanism and profile format for servers to be aware of device capability information.

16. Claims 16-18, 24-26, 35-37 are rejected for similar reasons as stated above.

Claims 11-13, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of Hwang (US 2003/0126239).



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17. Referring to claim 11, Shinohara discloses the invention substantively as described in claim 1. Shinohara further discloses an interface unit performs transmission/reception of data to/from the terminal device and the mobile telephone (§§ 54-56), however does not explicitly disclose the actual protocols or formats used to transfer data between the mobile telephone and the terminal device. In analogous art, Hwang discloses another communications network which utilizes UPnP to communicate between a gateway device (i.e. mobile communications terminal) and various devices (Figures 2, 5, and 6; §§ 10, 28, 44-46). It would have been obvious to one of ordinary skill in the art to substitute the communications unit between the mobile telephone and the terminal of Shinohara with the UPnP network interface described in Hwang in order to realize the benefits of using UPnP for communications, specifically to provide a common protocol for making various devices having different standard specifications interface with each other by expanding the existing plug and play function as described in Hwang (§§ 6).

18. Referring to claim 12, Shinohara-Hwang discloses the mobile communications device acts as an Internet gateway device via a UPnP network (Hwang: §§ 10).

19. Referring to claim 13, Shinohara-Hwang discloses the UPnP network is a wireless UPnP network (i.e. radio network equipment) (Hwang: §§ 5).

20. Claims 30-32 are rejected for similar reasons as stated above.

**Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joseph E. Avellino, Examiner  
November 4, 2007